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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,134	07/27/2001	Jerry Pavelka	00635245	2220

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EXAMINER

NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,134

Applicant(s)

PAVELKA, JERRY

Examiner

Paul Nguyen-Ba

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This action is responsive to:
 - a. Notice of Change of Address filed on 3/14/2005,
 - b. Response to Notice to File Missing Parts of Non-Provisional Application filed on 11/27/2001, and
 - c. Original Application filed on 7/27/2001.
2. Claims 1-14 are currently pending. Claims 1 and 8 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1 and 8, the language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. §101. Claim 1 needs to be directed to a "computer-

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implemented" method. Claim 8 needs to necessarily be implemented in hardware (i.e. processor).

Claims 2-7 and 9-14, are dependent upon claims 1 and 8, and do not add any limitations that would render these claims statutory under 35 U.S.C. § 101. Therefore, these claims are likewise rejected.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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6. Claims 1-3, 6-10, 13, and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by "Solving Print Production Problems with Acrobat InProduction", White Paper, Adobe Systems Inc., pgs. 1-11, *at least prior to April 2, 2001* (via HotBot Advanced Search Engine) (Hereinafter "InProduction").

The cited White Paper discusses how the Adobe Acrobat InProduction 1.0 professional toolset provides solutions to common print production problems, such as enabling bleed and trim specifications.

Regarding independent claim 1, InProduction discloses:

A method for entering advertising registration marks into an image comprising the steps of:
 generating specification data for a plurality of advertising registration marks (see pg. 6 – 1st full paragraph);
 inserting a plurality of advertising registration marks into an image at locations determined by the specification data (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)); and
 displaying the image (see Figure on pg. 6).

Regarding independent claim 8, InProduction discloses:

A system for entering advertising registration marks into an image comprising the steps of:
 a means for generating specification data for a plurality of advertising registration marks (see pg. 6 – 1st full paragraph);
 a means for inserting a plurality of advertising registration marks into an image at locations determined by the specification data (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)); and
 a means for displaying the image (see Figure on pg. 6).

Regarding claims 2 and 9, InProduction discloses:

...wherein one of the advertising registration marks is a trim mark (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)).

Regarding claims 3 and 10, InProduction discloses:

...wherein one of the advertising registration marks is a bleed mark (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)).

Regarding claims 6 and 13, InProduction discloses:

...wherein the step of generating specification data is comprised of a step of accessing a computer memory containing correlation between a user designation and a plurality of dimensional specifications for advertising registration marks (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph), and corresponding Figure).

Regarding claims 7 and 14, InProduction discloses:

...further comprising a step of scaling a relative size of at least one registration mark with respect to the image information (see pg. 6 – bottom two paragraphs and corresponding Figure).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Solving Print Production Problems with Acrobat InProduction", White Paper, Adobe Systems Inc., *at least prior to* April 2, 2001 (via HotBot Advanced Search Engine) (Hereinafter "InProduction"), in view of admitted prior art (admissions – pg. 2 of Applicant's Specification (1st – 3rd paragraphs)).

Regarding claims 4, 5, 11, and 12, InProduction does not explicitly disclose:

...wherein one of the advertising registration marks is a "live" or "gutter" mark.

However, Admission discloses on pg. 2 → 1st - 3rd paragraphs:

...wherein one of the advertising registration marks is a "live" or "gutter" mark (see Applicant Specification – pg. 2 → live marks and gutter marks "are well-recognized in the field and may be currently generated with a variety of computer programs that are used to generate advertising image information").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include live and gutter advertising registration marks for the motivational purpose of further enhancing the ability to include a greater variety of advertising layout registration marks along with the advertising copy transmitted to the printer or publisher.

Conclusion


9. The prior art made of record on form PT0-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB
11/29/2005


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